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EXAMINER

PORTNER, VIRGINIA ALLEN

ART UNIT

PAPER NUMBER

1645

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/252,691

Applicant(s)

Weinstock

Examiner

Partner

Art Unit

1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 25, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14-50 is/are pending in the application.
- 4a) Of the above, claim(s) 14-28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42 and 46 is/are allowed.
- 6) ☒ Claim(s) 1-10, 29-41, 43-45, and 47-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-10 and 14-50 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

Claims 10-13 have been canceled.

Claims 1-10, 14-28, 29-50 are pending.

Claims 14-28 stand withdrawn from consideration.

Claims 1-10 and claims 29-50 are under consideration.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Allowable Subject Matter***

2. Claims 42 and 46 define over the prior art of record and are allowed.

### ***Rejections Withdrawn***

3. Claims 11-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for probes and primers, the instant specification, does not reasonably provide enablement for gene therapy using the elected SEQ ID NO 7056. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims, in light of the fact that claim 12 recites an adjuvant and claim 13 contains a pharmaceutically active ingredients, thus defining claim 11 from which claims 12 and 13 as a pharmaceutical composition, a composition analogous to that of a vaccine, in light of the claims having been canceled.

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4. Claims 10, 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, in light of the amendment of claim 10 to no longer recite a polypeptide of any biological function and arguments with respect to claims 37-38.

***Rejections Maintained***

5. Claims 1-10 and claims 29-41, 43-45, 47-50 rejected under 35 U.S.C. 101 because the claimed invention is not supported by a specific, credible and substantial asserted utility or a well established utility for the elected invention of SEQ ID NO 7056 or SEQ ID No 1394 that encodes a polypeptide for reasons of record in paper number 14, paragraph 10.

6. Claims 1-10 and claims 29-41, 43-45, 47-50 rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific, credible and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention for reasons of record in paper number 14, paragraphs 10 and 11.

7. Claims 29, 33, 37-38 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid sequence SEQ ID No 1394 for the detection of *E.coli* in a sample, does not reasonably provide enablement for the use of any nucleic acid that only

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shares 70% sequence identity with SEQ ID No 1394, based upon nucleic acid changes encompassed by claiming the isolated nucleic acid sequence by SEQ ID No 7056. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use a nucleic acid sequence that only shares 70% sequence identity with SEQ ID 1394, the invention commensurate in scope with these claims, for reasons of record in paper number 22, paragraph 21.

*10 Blattner 37 Blattner*

8. Claims 5, 9, 29 (no specified size for the polypeptide) and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Blattner et al (January 29, 1997 (EMBL record, see sequence alignments **AE000213 and AAC74219**) or Oshima et al (1996,EMBL sequence alignments D90748 and BAA35957 ), in light of the disclosed sequence of Blattner sharing 100% sequence identity over at least 30 nucleic acids (encodes for 10 amino acids) and the claimed product is not so limited as being a E.cloace specific nucleic acid sequence.

***Response to Arguments***

9. Applicant's arguments filed March 25, 2002 have been fully considered but they are not persuasive.

10. The rejections of claims 1-10 and claims 29-41, 43-45, 47-50 under 35 U.S.C. 101 and 35 U.S.C. 112, first are argued by asserting that utility of the polypeptide has been established in the instant specification, in the annotation in Table 2, and the disclosed sequence.

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11. It is the position of the examiner that at page 53, line 7, the sequences are asserted to have putative identification and function, Table 2 defines SEQ ID No 7056 as a hypothetical protein through reference to the “*ymfc* (b1135) gene” and no other specific descriptions could be found in the specification. The hypothetical protein of another bacteria by reference would define the instant sequence as a hypothetical protein in the absence of clarifying narrative.

The specific accession number P75966 was created November 1, 1997, but the comment section appears to be dated November 23, 1998 and defines the hypothetical protein to be a member of the pseudouridine synthase family. The description was provided to the public about *ymfc* after the filing date of the instant specification. The EMBL database print out defines the accession number of Blattner to be a hypothetical protein, and the instant sequence is identified with reference to *ymfc*, and by correspondence to a hypothetical protein can be considered to be a hypothetical protein as well. At the time of filing, applicants hypothetical protein had not been identified with any specific biological activity.

12. Applicant provides a list of 6 different components that are asserted to define utility for the claimed products of the Amendment dated June 22, 2001, at section II, pages 7-8.

13. It is the position of the examiner that the primary structure of a putative polypeptide does not define the nucleic acid that encodes the polypeptide as a specific diagnostic agent and the polypeptide is not defined to have any specific function, just a putative structure.

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Homology with other known polypeptides or nucleic acids does not define a nucleic acid as a specific diagnostic reagent, nor does it establish the polypeptides specific function. Applicant has provided evidence to this effect by submission of Exhibit B and the Koonin reference which shows conserved sequences for the encoded polypeptides. A nucleic acid molecule that would hybridize to a pseudouridine synthase open reading frame need not be specific to *E. Cloacae*, but would hybridize to any one of the other bacteria shown in Exhibit B or Koonin due the highly conserved sequences that encode the identical amino acid sequences.

While established data bases are invaluable in assisting molecular biologist in furthering research, the instant specification does not define the claimed nucleic acid as encoding a polypeptide of any known function based upon structural homology with other known sequences.

14. Applicant asserts that the claimed polypeptide is a pseudouridine synthase.

15. The examiner requests Applicant to point to the section of the instant specification that defines the claimed nucleic acid to encode a polypeptide with pseudouridine synthase biological activity. The examiner was unable to locate that portion of the instant specification that teaches SEQ ID No 1394 to encode a polypeptide or protein of SEQ ID No 7056 which has pseudouridine synthase biological activity. Filing of an Application that teaches the polypeptide with this function could obviate the rejection made of record under 35 U.S.C. 101.

With respect to the Koonin et al reference submitted to define the biological significance of pseudouridine synthase biological activity, the examiner requests Applicant to point to that

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section of the instant specification that incorporates specific guidance and teaching that SEQ ID NO 1394 encodes a homolog of the protein disclosed by Koonin et al (1996). Koonin et al does not mention anything about E.cloacae what so ever in the reference. One of skill in the art would not have ascertained that the E.cloacae nucleic acid that encodes pseudouridine synthase biological activity was known in light of the disclosure provided by Koonin et al.

16. The rejection of Claims 5, 9, 29 (no specified size for the polypeptide) and 50 under 35 U.S.C. 102(b) as being anticipated by Blattner et al (January 29, 1997 (EMBL record, see sequence alignments **AE000213 and AAC74219**) or Oshima et al (1996,EMBL sequence alignments D90748 and BAA35957 ), argued by asserting that Blattner et al does not show a nucleotide sequence of greater than 23 sequential nucleotide bases of SEQ ID NO 1394 and **Exhibit A** is asserted to show a BLAST alignment which shown that the cited references do not meet the recited claim limitations.

17. It is the position of the examiner that the sequence alignment of Blattner et al's sequence with the sequence of the instant Specification, with respect to a polynucleotide, SEQ ID No 1394, that encodes for the amino acid sequence of SEQ ID No 7056, shows 94 % over all sequence identity for the nucleic acid coding sequence.

The amino acid sequence of Blattner shows two extensive stretches of identical amino acids, the first being a sequence of 25 sequential or consecutive amino acids that would be encoded by 75 nucleotides that would hybridize to the instantly claimed nucleic acid, and the



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second being a sequence of 52 sequential or consecutive amino acids that would be encoded by 156 nucleotides that would hybridize to the instantly claimed nucleic acid (see alignment previously provided and attached hereto).

The entire sequence of Blattner et al shows 94% sequence identity and would definitely hybridize with the instantly claimed nucleic acid molecule under stringent conditions.

**Exhibit B** was noted by the examiner to show conserved regions of known pseudouridine synthases, but *E. cloacae* is not mentioned, the molecules are taught to vary in relative molecular weight from 25 to 40 kDa and the consensus pattern shown is not discussed in the instant specification.

The PROSITE document amino acid sequence GRLD is taught to be conserved among pseudouridine synthases. Upon reconsideration of the oligomer search done by the examiner, it was found that a molecule that has ferritin binding activity contains this consensus sequence and is not a pseudouridine synthase (see WO96/41172 sequence alignment provided).

18. The rejection of claims 29, 33, 37-38 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid sequence SEQ ID No 1394 for the detection of *E. cloacae* in a sample, does not reasonably provide enablement for the use of any

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nucleic acid that only shares 70% sequence identity with SEQ ID No 1394, based upon nucleic acid changes encompassed by claiming the isolated nucleic acid sequence by SEQ ID No 7056. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use a nucleic acid sequence that only shares 70% sequence identity with SEQ ID 1394, the invention commensurate in scope with these claims is traversed on the grounds that the claimed nucleic acid can be used to express a polypeptide as described in the specification at page 50 and is well known in the art, as well as can be used for drug screening as described at page 78-81.

19. It is the position of the examiner that a nucleic acid sequence claimed based upon an amino acid sequence permits up to 30% sequence differences over the entire length of the nucleic acid sequence, in light of degenerate codons. As the specification does not teach what function the polypeptide has, or regions of the nucleic acid can be changed, or are conserved and specific to *E.coliace* differences in nucleic acid sequence of 30% would not predictably detect *E.coliace* under low stringency conditions because no specific guidance has been provided as to where changes in the nucleic acid sequence can be made to permit the nucleic acid sequence specifically detect *E.coliace* in a sample. No specific utility has been disclosed for the claimed polypeptide, and nucleic acid sequences claimed based upon a polypeptide amino acids sequence that has not been described in such a way as to define the polypeptide as being *E.coliace* specific would not predictably detect *E.coliace* in a sample, when the nucleic acid sequence evidences changes of up to 30%.

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In support for the position, Blattner et al (reference of record) discloses a nucleic acid sequence that shares 100% sequence identity with SEQ ID No 7056 over 185 nucleic acids, wherein the nucleic acid sequence was obtained from E.coli and encodes over 50 amino acids that share 100% identify with SEQ Id No 7056. Thus a nucleic acid claimed based upon the recited amino acid sequence would not be predictably detect E.cloace specific and would therefore not permit the person of skill in the art to use the claimed nucleic acid to detect E.cloace in a sample with any certainty in light of the nucleic acid sequence taught in the prior art that shares such a high degree of homology with the claimed sequence.

No specific guidance has been provided in the instant specification and the person of skill in the art would not be able to make and use a nucleic acid to predictably detect E.cloace which shares about 67 % sequence identity with SEQ ID 1394, or a sequence of any size that shares 90% or 95% with SEQ ID No 7056 because where and how the nucleic acid sequence could be changed and still predictably detect E.cloace has not been described, and the claimed nucleic acid can be any size and is a sequence that shares the recited percentage identity of that portion of SEQ ID No 7056 to which it corresponds because the size of the nucleic acid molecule is not specified. No nucleic acid sequences that are specific to only E.cloace are specifically claimed.

### ***Conclusion***

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this group is (703) 308-4242.

The Group and/or Art Unit location of your application in the PTO will be Group Art Unit 1645. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to this Art Unit.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp  
August 9, 2002

  
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